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IN THE  
**Supreme Court of the United States**  
OCTOBER TERM, 1990

FEIST PUBLICATIONS, INC.,

*Petitioner,*

v.

RURAL TELEPHONE SERVICE COMPANY, INC.,

*Respondent.*

ON WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS  
FOR THE TENTH CIRCUIT

**BRIEF OF GTE CORPORATION  
AS AMICUS CURIAE IN SUPPORT  
OF RESPONDENT RURAL TELEPHONE  
SERVICE COMPANY, INC.**

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**QUESTION PRESENTED**

Does the copyright in a telephone directory by the telephone company prevent access to that directory as a source of names and numbers to compile a competing directory, or does copyright protection extend only to the selection, coordination, or arrangement of those names and numbers?

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**BRIEF OF GTE CORPORATION AS  
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**PRELIMINARY STATEMENT**

GTE Corporation submits this brief as *amicus curiae*, under Rule 37.3 of the Rules of this Court, in support of respondent Rural Telephone Service Company, Inc.<sup>1</sup>

**INTEREST OF THE AMICUS**

GTE Corporation is the parent of numerous business units engaged in the core areas of telecommunications, lighting, and precision materials. This litigation is of primary interest to GTE Telephone Operations, GTE Directories Corporation, and GTE Information Services.

The GTE Telephone Operating Companies comprise seven local exchange telephone companies operating in 31 states. As local exchange telephone companies, the GTE Telephone Operating Companies distribute directories in each of their exchanges. Generally, these directories include both white pages and yellow pages. The copyrights in the directories are owned by the respective GTE Telephone Operating Companies. The GTE Telephone Operating Companies also license the directory listings from the white pages to other directory publishers. In the event the Court holds telephone directories not to be copyrightable, or otherwise renders a

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<sup>1</sup> This brief is submitted with the consent of the parties. The written consents of petitioner and respondent have been entered with the Clerk of the Court.



decision that would permit independent directory publishers to copy the directory lists at will, the ability of the GTE Telephone Operating Companies to realize revenue in exchange for the right to use their lists will be severely curtailed.

The interest of GTE Directories Corporation ("GTE/DC") in the outcome of this litigation is threefold. As the directory publisher for all GTE Telephone Operating Companies, as well as for more than one hundred non-affiliated telephone companies, GTE/DC desires to see proper copyright protection for the directories produced and processed through and by GTE/DC. The ability to license listings not only is a source of revenue for the telephone companies, but also, when bound together with the classified yellow pages, provides for a complete, up-to-date directory for the end user.

Secondly, as a publisher of directories for both telephone operating companies and independent distributors, GTE/DC is concerned with any decision that affects the scope of protection to be afforded for compilations, since a sweeping decision could affect the copyright protection afforded the classified sections of a directory. Protection of the content and form of both white pages and classified sections is essential to maintaining the commercial value of those directories.

Lastly, GTE/DC has been involved in the development of valuable data bases arising from its involvement in both telemarketing of consumer goods, and from its publication and distribution of tourism information on behalf of a half dozen states. Many of these ventures are now part of GTE Information Services ("GTE/IS"). Because GTE/IS is engaged in numerous ventures which depend heavily on protection of its intellectual property rights, including rights in emerging data bases, GTE/IS has intense concerns about the manner in which the outcome of this litigation will affect the protection of those rights.

Accordingly, GTE Corporation believes that, as a result of its significant participation in the telephone, directory publishing and information services industries, it is able to bring a unique perspective to bear on this litigation.

## SUMMARY OF THE ARGUMENT

Because petitioner's directory is substantially similar to the copyrightable expression protected by respondent's copyright, the Court should AFFIRM the decision of the Court of Appeals below.

Under the Copyright Act of 1976, copyright protection subsists in all "original works of authorship fixed in a tangible medium of expression." 17 U.S.C.A. § 102(a). In the copyright context, the term "original" is taken to require only that the work in question was independently created by, and owes its origin to, the author.

Applying the statutory standard, the Courts of Appeals have been uniform in holding that telephone directory listings are copyrightable, both as "original works of authorship" under 17 U.S.C.A. § 102(a) and as "compilations" under 17 U.S.C.A. § 103. Furthermore, the history of the Copyright Act demonstrates that Congress intended directories to be copyrightable. The purposes articulated in the Copyright Clause do not limit Congress's power to so legislate. Accordingly, proper application of copyright law leaves no doubt regarding the copyrightability of telephone directory listings or other compilations of fact or data.

The perceived reliance, attributed by petitioner and others to the Seventh, Eighth, and Tenth Circuits, on a "sweat of the brow" doctrine as the supporting rationale for the copyrightability of compilations of data is misplaced. Reliance on "sweat of the brow" notions appears to be the result of a misapprehension of copyright law that would impose

qualitative concepts, such as ingenuity, creativity, or aestheticism, as prerequisites to copyrightability.

In deciding a claim of copyright infringement, well settled application of copyright law requires only that the copyright owner establish that the accused infringer had access to the copyrighted work and that the allegedly infringing work is substantially similar to the protectible expression of the copyrighted work. Petitioner here admits access to and copying of respondent's copyrighted directory. Therefore, infringement is established when respondent demonstrates that the accused telephone directory is substantially similar to the protectible expression of the copyrighted directory.

When *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), was decided, the Court indicated that it need not, at that time, decide the manner in which uncopyrightable elements — facts — combine with an author's original expression to form copyrightable works. That issue is squarely confronted here. In Section III, *infra*, the proper scope of copyright protection in directories or other compilations of fact or data is shown to include and protect the expression that results from, *inter alia*, the author's *collection* of data. With a recognition of the proper scope of copyright protection, it is possible to undertake a rational and consistent approach to the infringement of compilations.

Petitioner and others would seek to legitimize activity that, under proper application of settled copyright law, constitutes infringement of the copyright in respondent's telephone directory. Specifically, petitioner urges a construction of copyright law that would allow it to use a copyrighted directory as the source from which it would publish its own directory. A proffered justification for such legitimization is the alleged "independent verification" undertaken in the compilation of the infringing directory.

Although language can be found in some judicial decisions that might appear sympathetic to the notion, no court has yet held that any amount of "independent verification" operates to mitigate activity that otherwise constitutes infringement of a copyrighted telephone directory. Furthermore, no court has suggested that independent verification, or similar activity, should have an exculpatory effect on the infringement of copyrighted works other than telephone directories. Accordingly, petitioner would create a defense to the infringement of telephone directories that has no analog elsewhere in copyright law.

Finally, petitioner's suggestion that maintaining the copyrightability of telephone directory listings "freeze[s] access to public domain materials" is disingenuous. The scope of copyright protection afforded telephone directory listings is measured as it is with respect to all other copyrighted works, and operates to preclude others only from copying more than an insubstantial portion of the copyrighted work. Petitioner remains free to independently create a directory, even a directory identical to the copyrighted directory, provided his creation does not involve copying from the copyrighted directory.

## ARGUMENT

### I. AN EXTENDED HISTORY OF DECISIONAL AND STATUTORY LAW LEAVES NO DOUBT THAT TELEPHONE DIRECTORIES, AND OTHER COMPILATIONS OF DATA, ARE COPYRIGHTABLE.

Under the Copyright Act of 1976, 17 U.S.C.A. §§ 101-914 (1990) ("the Copyright Act"), copyright protection subsists in all "original works of authorship fixed in a tangible medium of expression." 17 U.S.C.A. § 102(a). In the copyright context, the term "original" is taken to require only that



the work in question was independently created by, and owes its origin to, the author.

Applying the statutory standard, the Courts of Appeals have been uniform in holding that telephone directory listings are copyrightable, both as "original works of authorship" under 17 U.S.C.A. § 102(a) and as "compilations" under 17 U.S.C.A. § 103. Furthermore, the history of the Copyright Act demonstrates that Congress intended directories to be copyrightable. The purposes articulated in the Copyright Clause, U.S. Const. art. I, § 8, cl. 8, do not limit Congress's power to so legislate. Accordingly, proper application of copyright law leaves no doubt regarding the copyrightability of telephone directory listings, or other compilations of fact or data.

For a more thorough treatment of the copyrightability of telephone directories, the Court's attention is directed to the brief of respondent, Rural Telephone Service Company, Inc.

## II. PETITIONER'S PERCEPTION OF DISPARITY INVOLVING THE "SWEAT OF THE BROW" AND THE "SUBJECTIVE SELECTION" TESTS IS MISPLACED.

The Court has acknowledged that copyright law is unsettled regarding the manner in which uncopyrightable elements combine with an author's original contributions to form protected expression. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 548 (1985). And while there is no

doubt that facts, *per se*, are not subject to copyright protection, see *Miller v. Universal City Studios, Inc.*,<sup>2</sup> 650 F.2d 1365, 1368-69 (5th Cir. July 1981), and cases cited therein, there exists no uniform articulation of the standard to be applied when determining whether a compilation of factual data, e.g., a telephone directory, exhibits sufficient "originality" to qualify for copyright protection.

The want of a uniformly articulated standard has engendered some degree of inconsistent treatment by courts that have been required to determine the copyrightability, *vel non*, of compilations of data.<sup>3</sup> However, while the courts may appear to endorse various theories of copyrightability, even when considering similar works, they uniformly have enforced copyright protection in such works.

<sup>2</sup> Manifestly, policy considerations that circumscribe the scope of copyright protection in a factual *narrative*, such as was involved in *Miller*, are largely inapposite when applied to the purely commercial activity of publishing telephone directories or most other compilations of data. That is, copyright cases involving factual narratives or historical works reflect the view that the cause of knowledge is best served when historical or scientific information is made the common property of all, so that each generation would remain free to draw on the discoveries and insights of the past. Cf. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980). Such noble considerations are not generally at work when telephone directories or other compilations of data are misappropriated. Petitioner does seek to build on the store of knowledge, but only to expeditiously gain commercial advantage from a copyrighted work owned by respondent.

<sup>3</sup> See *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2d Cir. 1984) ("Copyright law and compilations are uneasy bedfellows . . ."); *Rand McNally & Co. v. Fleet Management Sys.*, 634 F. Supp. 604, 608 (N.D. Ill. 1986) ("The copyrightability of factual compilations . . . presents intellectual difficulties in determining where protectible copying of facts ends and unlawful copying of the compilation begins."); *Moore v. Lighthouse Publishing Co.*, 429 F. Supp. 1304, 1309 (S.D. Ga. 1977) ("One emerges from this jungle of generality, contradiction and uncertainty with the impression that the only thing certain in this area of law is the lack of it.").

Petitioner perceives opportunity in this lack of uniformity and suggests to the Court that the Courts of Appeals are split on the copyrightability of directories or that they are erroneously enforcing copyright protection in such directories. Pet. Br. at 5 and 15-18.

Specifically, petitioner contends that the Fifth Circuit in *Rockford Map Publishers, Inc. v. Directory Serv. Co.*, 768 F.2d 145 (5th Cir. 1985), cert. denied, 474 U.S. 1061 (1986), the Eighth Circuit in *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985) and in *United Tel. Co. of Mo. v. Johnson Publishing Co., Inc.*, 855 F.2d 604 (8th Cir. 1988), and the Tenth Circuit below have adopted a "sweat of the brow" theory in support of copyrightability for telephone directories. Petitioner proposes that the Second, Fifth, Ninth and Eleventh Circuits have rejected the "sweat of the brow" theory and cites cases it believes support that proposition.<sup>4</sup> The appropriate standard, according to petitioner, would consider only the selection, coordination, or arrangement of the copyrighted work. Based solely on those factors, a determination is to be made whether the work, as a whole, qualifies as an original work of authorship. Pet. Br. at 18. The alternative standard advanced by petitioner has been generally referred to as the "subjective selection" test. See Note, *Copyright Protection for Factual Compilations — Reviving the Misappropriation Doctrine*, 56 Fordham L. Rev. 933 (1988).

<sup>4</sup> Petitioner contends that the Ninth Circuit had at one time subscribed to the "sweat of the brow" test in *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937), but that it rejected that test in *Worth v. Selchow & Righter*, 827 F.2d 569 (9th Cir. 1987), cert. denied, 485 U.S. 977 (1988). This contention is a misapprehension of *Worth*. *Worth* was a decision on appeal from the denial of a motion for summary judgment of copyright infringement. In affirming, the Ninth Circuit did not address the copyrightability of *Worth's* encyclopedia, but merely held that the accused game (*Trivial Pursuit*) was not substantially similar to the protectible expression embodied in *Worth's* copyrighted works. Accordingly, *Worth* speaks not to the copyrightability of compilations of data, but to the scope of copyright protection in a specific example of such compilations.

Petitioner's emphasis on its perceived split among the circuits represents an attempt at the sublimation of form into substance. Irrespective of the rationale deployed, courts uniformly apprehend copyrightability in telephone directories and other compilations of factual data, provided that the requisite level of statutorily founded originality is deemed to exist.<sup>5</sup>

The decision of the Fifth Circuit in *Rockford Map* adopts a cogent approach to a determination of the copyrightability of compilations of data, and in so doing largely belies the need to accept petitioner's invitation to choose between "sweat of the brow" and "subjective selection" criteria.

In *Rockford Map*, the accused infringer, Directory Service, argued that since Rockford Map had spent little time preparing its maps, its efforts were "not very industrious" and that, therefore, Rockford Map's plat maps were not copyrightable. 768 F.2d at 148. The Court rejected Directory Service's argument and emphasized that the amount of time spent creating the copyrighted map was irrelevant to copyrightability. The *Rockford Map* decision is correctly recognized, not as rejecting "sweat of the brow" as a basis for protection, but rather as recognizing that relevant precedent<sup>6</sup> determined the copyrightability of compilations according to whether the compiler produced an original arrangement or presentation of facts — that is, whether the author added something of himself — and not the amount of time the work consumed. *Id.* See Note, *Copyright Protection for Compilations of Fact: Does the Originality Standard Allow Protection*

<sup>5</sup> It is widely agreed that copyright law firmly establishes that the requirement of originality does not refer to a desired modicum of artistic merit, but rather to the consideration that the work has been independently created. See Patry, *Copyright in Collections of Facts: A Reply*, 6 Comm. & L. 11, 19 (1984).

<sup>6</sup> *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922); *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977).



on the Basis of Industrious Collection?, 62 Notre Dame L. Rev. 763, 772 (1987).

The tendency to overstate the significance of any tension between "sweat of the brow" and "subjective selection" has not been lost on others. *Amici curiae*, Independent Industry Association ("IIA"), ADAPSO, and The Computer and Software Services Industry Association, Inc. ("IIA, et al."), concur that:

the dichotomy may be much less sharp than petitioner suggests. Indeed common threads running throughout the precedential fabric suggest that any "split in principle" may have a limited practical effect, and that any doctrinal "division" can be bridged.

Br. of Amici IIA, et al. at 15 (footnotes omitted).

In addition, at least one commentator has opined that where factual compilations are concerned, courts should apply a broad standard of originality, based on the language of the statute, which suggests that "*both labor and arrangement/selection factors must be considered.*" Note, *supra* p. 8, 56 Fordham L. Rev. at 934 (emphasis added).

It would appear that some courts, when upholding the copyrightability of works that are clearly worthy, feel unnecessarily compelled to fortify their finding of originality with a rationale that can be associated with either "sweat of the brow" or "subjective selection" considerations. However, on occasion courts have taken the opportunity to hold that telephone directories in question satisfy the criteria for copyrightability under either criterion.<sup>7</sup>

<sup>7</sup> See *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers, Inc.*, 756 F.2d 801, 810, n.9 (11th Cir. 1985); *BellSouth Advertising and Publishing Corp. v. Donnelly Information Publishing, Inc.*, 719 F. Supp. 1551, 1557 (S.D. Fla. 1988).

A survey of cases deciding the copyrightability of compilations, conducted with particular attention to the nature of the copyrighted works in question, impels the ineluctable conclusion that the two criteria are not mutually exclusive, and are probably not exhaustive of those criteria that may be justifiably relied on by a court in support of its finding of originality. The appropriate determinant of copyrightability is not the nature of the activity engaged in by the author — unless that activity happens to be copying — "but rather the nature of the final result." *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 808 F.2d 204, 207 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987). There appears palpalable merit in the suggestion that:

Much in the case law supports a view of the two tests for compilation authorship as complementary rather than conflicting. The low threshold of originality may be met by considering both the author's activity in collecting and assembling the data, and his activity in selecting, coordinating or arranging it. Such an approach gives effect to the full text of the [Copyright] Act's definition of compilation, 17 U.S.C. sec. 101, and recognizes the role played by all listed aspects of compilation authorship.

Br. of Amicus IIA, et al. at 17.

Nevertheless, petitioner's attack on "sweat of the brow" as a valid foundation for copyrightability of fact or data compilations warrants response.

It cannot be reasonably contended that the diligent and industrious compiler of a directory, by virtue of his efforts, will have failed to create a work that comports with the minimal requirements of originality; the compiler's efforts will almost assuredly result in a work of independent creation. To deprive a compiler of copyright protection in such circumstances effectively removes the primary incentive for authors



to incur labor, expense and effort in the creation and dissemination of works, which, in turn, benefit the public. See Chafee, *Reflections on the Law of Copyright: I*, 45 Colum. L. Rev. 503, 506 (1945) (arguing that, ideally, the primary purpose of copyright is to benefit the author). In effect, disparagement of the copyright value of directories and other compilations ultimately undermines the copyright policy that is designed to "assure contributors to the store of knowledge a fair return for their labors." *Harper & Row, Publishers, Inc.*, 471 U.S. at 546.

It would appear that any unwillingness to consider the labor expended in the creation of a compilation derives from the misplaced view that to do so is tantamount to affording protection to research or to labor *qua* labor, which is generally regarded to be beyond the scope of copyright protection. However, this view overlooks the fact that, in authoring a directory or a compilation, the compiler independently creates a *collection* of facts or data. What must be recognized is that the collection the compiler creates represents expression. To wit: the compiler independently creates a single source of those facts, as distinguished from disparate sources of the dispersed individual facts that existed prior to the compiler's creation. This collection created by the compiler merits protection because it represents the compiler's *expression* of that set of facts. See Note, *supra* p. 8, 56 Fordham L. Rev. at 945.

In addition, there seems to be a tendency to minimize the level of effort or expense incurred, and discretion exercised, in selecting, collecting, coordinating and arranging the data that constitutes a telephone directory. It should be realized that the following activity is typically required to create a telephone directory.

In the course of providing new telephone service or changes to current telephone service, the telephone company obtains the name and address, as well as, in many instances, employment information and other information relevant to

maintaining a relationship with a subscriber. The telephone company then assigns the telephone number.

Business subscribers provide not only the business name and address to the telephone company, but in many instances will provide fictitious business name statements or copies of business licenses to the telephone company supporting the appearance of its name in the alphabetical and classified sections of a telephone directory. The business will receive at least one telephone number, perhaps more.

All this information obtained by the telephone company appears in a document which may be called a "service order." The service order may contain several pages of information, including not only credit information and location of the business but also data concerning the type and number of telephone instruments, whether or not the telephone number is to be jointly used by multiple businesses, and the number of telephone lines and alternate call numbers assigned to the business customer.

Subsequently, all or part of the information is entered into a data base to create a directory in accordance with instructions concerning the geographic boundaries and other specifications for the directory.

In addition to collecting and arranging massive amounts of data, the telephone company also makes selective decisions concerning the geographic scope of each of the directories within its franchise area. It may subdivide directories into different geographic directories, may include in a single directory subdivisions by county, town, or other geographic area; it may include zip codes along with the names, addresses, and telephone numbers, and may include through licensing or cross-licensing agreements listings from other adjoining telephone franchise areas. Telephone companies may print business listings in different type style, sometimes selling bold or highlighted listings in the alphabetical section of the directory. Geographic boundaries frequently change to

serve the needs of end-users, expanding and contracting the boundaries contained in the directory to enhance the ability of the directory to compete effectively with other directories in the marketplace by making the areas covered by the directory correspond to shopping patterns in the community served by the directory.

Accordingly, any inclination to derogate the nature of the activity engaged in by a telephone company or a directory publisher in creating a telephone directory reflects a misapprehension of that activity.

As maintained above, the copyrightability of any work is properly viewed to turn primarily on *the nature of the work itself*, rather than on a characterization of the activity engaged in creating the work. With this in mind, there is no doubt that preserving copyright protection in telephone directories and other compilations of data is clearly warranted by the policies underlying copyright law, regardless of the doctrines or rationales relied on in furtherance of those policies.

### **III. PROPER COPYRIGHT INFRINGEMENT ANALYSIS REQUIRES AN ASSESSMENT OF THE SCOPE OF COPYRIGHT IN RESPONDENT'S DIRECTORY AND A DETERMINATION THAT PETITIONER'S ACCUSED DIRECTORY IS SUBSTANTIALLY SIMILAR TO THE PROTECTIBLE EXPRESSION EMBODIED IN RESPONDENT'S DIRECTORY.**

#### **A. An Adequate Assessment Of The Scope Of The Copyright In Telephone Directories And Other Compilations Of Data Recognizes That Protectible Expression Results From The Collection Of Data In A Directory Or Compilation.**

In order to prevail in its claim against an accused infringer, the owner of a copyright in a telephone directory or

any other copyrighted work must establish that the accused work is substantially similar to the protectible expression embodied in the copyrighted work.<sup>8</sup> *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 912 (2d Cir. 1980); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980). See also, *Warner Bros., Inc. v. American Broadcasting Cos.*, 530 F. Supp. 1187, 1190 (S.D.N.Y. 1982), *aff'd*, 720 F.2d 231 (2d Cir. 1983). It seems appropriate, therefore, in a copyright infringement analysis, to initially determine the proper scope of protection to be attributed to the copyrighted work. Having made this determination, it then remains only to decide whether the accused work constitutes an unlawful appropriation of material within the scope of the copyright in question.

The Copyright Act requires that protection in a compilation or derivative work (as those terms are defined in 17 U.S.C.A. § 101) "extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work." 17 U.S.C.A. § 103(b).<sup>9</sup> It has been recognized that § 103(b) has given rise to confusion

<sup>8</sup> More specifically, plaintiff's burden in a copyright infringement action is to demonstrate that defendant copied the requisite amount of protected material from plaintiff's work. Where direct proof of copying is not available, plaintiff must adduce circumstantial evidence, including proof of access to the copyrighted work by defendant. See W. Patry, *Latman's The Copyright Law* at 191-192 (6th ed. 1986). However, GTE Corporation is unaware of any reported case involving the infringement of a telephone directory or compilation of data in which access was in dispute.

<sup>9</sup> Petitioner cites § 103(b) as authority for the proposition that "[t]he only copyrightable interest RTSC can conceivably possess in the white page listings is in the exact arrangement of those listings 'as a whole'." Pet. Br. at 18. Apart from the fact that petitioner's asserted construction and application of § 103(b) flies in the face of the overwhelming weight of decisional law deciding the infringement of compilation copyrights, petitioner's assertion appears to align poorly with the legislative history of § 103.

(footnote continues)



regarding the scope of copyright protection in compilations. Note, *supra* p. 8, 56 Fordham L. Rev. at 948. Specifically, one source of confusion emanating from § 103 relates to "[w]hether the term 'material' [as used in § 103] applies to the data collected by the compiler, or whether it refers only to the compiler's manner of arranging and presenting the materials." *Id.* William Patry argues that if the former construction is intended, the result would be no protection for the copyright in a compilation of data. Patry, *supra* note 5, 6 Comm. & L. at 16. Surely this cannot be the statutory intent, but it is precisely the construction advocated by petitioner.

What is required is a principled valuation of the scope of copyright protection in compilations of data, a valuation that fairly respects the two competing interests invoked in copyright law: (i) the need to provide adequate incentive for the creation of original works of authorship and (ii) the need to preserve the free dissemination of information. Professor Robert Denicola has articulated an approach to copyright protection for compilations of data that eminently satisfies these requirements. See Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516 (1981).

Professor Denicola agrees that copyright law properly offers little to one intent on maintaining control over *individual* statements of fact, but suggests that "the calculus quickly changes as fact is piled upon fact to yield no longer a simple

(footnote continued)

In enacting § 103, Congress was principally concerned that the author of a derivative work based upon a work that itself was copyrighted or in the public domain might attempt to assert a copyright interest in the original work. Congress thus explained of § 103(b) that "[t]he most important point here is one that is commonly misunderstood today: Copyright in a 'new version' covers only the material added by the *later* author, and has no effect one way or the other on the copyright or public domain status of the existing material." H.R. Rep. No. 1476, 94th Cong., 2d Sess. at 57 (1976) (emphasis added); S. Rep. No. 473, 94th Cong., 2d Sess. at 55 (1976).

statement, but a catalog, encyclopedia, a directory." Denicola, *supra* p. 16, at 526. After discarding the "arrangement" of data in compilations and directories as an unsatisfactory touchstone of copyrightability, Professor Denicola persuasively concludes:

One promising approach is to find authorship in the act of aggregating isolated pieces of information. The particular *collection* of data would thus itself be a work of authorship. Unless the collection of data contained in the compilation has been copied from a preexisting source, it represents an original contribution of the author. The collection owes its origin to the author as much as does the manner in which the collection is arranged. This distinguishes the process of culling and assembling facts, which results in the collection, from the discovery of the facts themselves, and thereby secures a spot for the collection outside the category of discoveries, which are expressly excluded from copyright protection. . . . The cases sustaining infringement claims despite the absence of an appropriation of arrangement support the conclusion that the particular collection of data contained in a compilation may be considered a copyrightable element of the overall work.

*Id.* at 530 (footnotes omitted).

It would appear that copyright analysis of compilations according to the approach espoused by Professor Denicola would necessitate an evaluation of the degree of originality that derives from the particular collection of data. And, presumably, originality in this sense could arise as a result of



either "sweat of the brow" or "subjective selection" engaged in by the author.<sup>10</sup>

If nothing else, uniform adoption of this approach would have the obviously salutary effect of imparting needed rationality to copyright infringement analysis by obviating the spurious sweat-of-the-brow/subjective-selection disparity. In addition, it should not be assumed that the suggested approach forecloses the possibility that originality can inhere in a compilation as a result of factors other than the nature of the collection of data constituting the compilation. Professor Denicola perceives that the scope of copyright protection in compilations can, in fact, derive from additional elements, such as the arrangement of those facts within the compilation. *Id.* at 532.

A number of courts have readily recognized that the proper scope of copyright protection in directories and other compilations of data embraces more than the mere arrangement of data, although in some instances this recognition has been arrived at without reliance on a collection rationale as specifically articulated by Professor Denicola. These courts

<sup>10</sup> Although not an issue squarely before the Court in this case, the scope of copyright protection in factual narratives has proved nettlesome in the past. See, e.g., *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985); *Hoehling*, 618 F.2d 972. Denicola's "collection" rationale can be profitably applied:

While the specific literary expression is copyrightable, protection limited to the author's prose cannot prevent an appropriation of the labor and expense of the investigation itself. Such appropriations can be controlled, however, by analogizing from the compilation cases and recognizing authorship in the collection of data chosen by the nonfiction writer. Indeed, this appears to have been the basis for the district court opinion, [in *Miller v. Universal City Studios*] which in addition to a predictable reference to *Toksvig v. Bruce Publishing Co.*, 181 F.2d 664 (7th Cir. 1950)] cited *Leon* and *Southwestern Bell [Tel. Co. v. Nationwide Ind. Dir. Directory Serv., Inc.]*, 371 F. Supp. 900 (W.D. Ark. 1974)] — two directory cases supporting the collection rationale (footnote omitted).

Denicola, *supra* p. 16, at 538.

have held that any substantial appropriation of data from a copyrighted directory or compilation will implicate the copyright owner's exclusive rights.

In *Leon v. Pacific Tel. and Tel. Co.*, 91 F.2d 484 (9th Cir. 1937), the defendant had published a "numerical directory," in which he had taken information contained in the plaintiff's copyrighted alphabetical directory and published it in rearranged form, classifying it according to exchanges, and listing the telephone numbers in each exchange in numerically consecutive order. The number was followed by the subscriber's name; no address information was provided. The Ninth Circuit ruled in favor of the copyright owner, Pacific, primarily on the basis that the copyright included within its scope, not only the arrangement published by Pacific, but also other arrangements of the data Pacific had collected, regardless of whether Pacific had elected to use those other arrangements. *Id.* at 486.

An analogous result was reached in *Triangle Publications, Inc. v. New England Newspaper Publishing Co.*, 46 F. Supp. 198 (D. Mass. 1942). In *Triangle Publications*, the plaintiff published daily and monthly periodicals in the form of charts containing information on horse races. According to the court, the defendants committed infringement when they copied the plaintiff's symbols into charts, and also when they presented the symbols in narrative form. *Id.* at 202.

In this instance, the court again recognized a scope of copyright sufficiently expansive to protect more than the verbatim arrangement of the data compiled by Triangle Publications. The copyright was held to proscribe the substantial selective taking of the elements of data Triangle Publications had collected, irrespective of the manner in which New England Newspaper had rearranged that data.

*National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 552 F. Supp. 89 (N.D. Ill. 1982), squarely addresses the issue of copyright infringement in the context of computer data

bases.<sup>11</sup> D&B had for years published credit reference books as part of its credit reporting service. D&B's credit reference books contained financial and other information regarding certain businesses. NBL was in the business of selling customized mailing lists. NBL extracted information from D&B's credit reference books and loaded that information into NBL's computer data base. NBL supplemented the D&B information with information from other sources, including telephone directories. The information that NBL disseminated to its customers bore little similarity to the totality of the information that was extracted from D&B's books and loaded into NBL's data base.

NBL argued that the scope of copyright in compilations was limited, so that infringement could not be found unless "the facts in [NBL's mailing lists] are organized and presented in a manner which closely parallels their organization and presentation in [D&B's credit reference books]." *Id.* at 92. The court did not agree that the scope of copyright in compilations was so confined. In holding that NBL had committed infringement, it reasoned:

Compilations . . . have value because the compiler has *collected* data which otherwise would not be available. The compiler's contribution to knowledge normally is the collection of information, not its arrangement. If his protection is limited solely to the

<sup>11</sup> GTE Corporation concurs with *amici* IIA, *et al.* in the view that the outcome of this litigation promises to have a profound effect on the emerging information services industry. However, GTE Corporation does not suggest, as does IIA, *et al.*, that an idiosyncratic species of copyright law is required to address the competing interests in telephone directories.

form of expression, the economic incentives underlying copyright laws are largely swept away.

*Id.* (emphasis added).

**B. Petitioner's Directory Is Clearly Substantially Similar To The Protectible Expression Of Respondent's Directory.**

Having obtained a measure of the scope of copyright protection in telephone directories and other compilations of data, it remains only to determine whether an accused work, such as petitioner's directory, is substantially similar<sup>12</sup> to the protectible expression embodied in the copyrighted work.

Petitioner and others who find themselves poised to use portions of a copyrighted work are able to rely on the concept of substantial similarity<sup>13</sup> as a yardstick to modulate the nature and amount of data they are free to take from the work.

<sup>12</sup> Just as copying is an essential element of infringement, so substantial similarity between the plaintiff's and defendant's works is an essential element of copying. Yet, the determination of the extent of similarity which will constitute a *substantial* and hence infringing similarity presents one of the most difficult questions in copyright law, and one which is the least susceptible of helpful generalizations. It is clear that slight or trivial similarities are not substantial and are therefore noninfringing. But it is equally clear that two works may not be literally identical and yet, for purposes of copyright infringement, may be found to be substantially similar.

3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 13.03[A], at 13-23 (1990) (footnotes omitted).

<sup>13</sup> In fact, copyright infringement analysis invokes a prerequisite threshold inquiry, sometimes referred to as the "*de minimis*" test. See, e.g., *G.R. Leonard & Co. v. Stack*, 386 F.2d 38 (7th Cir. 1967). See also Nimmer, *supra* note 12, § 13.03[A], n.101, and cases cited therein. According to the *de minimis* test, an accused infringer is permitted to copy an amount of the copyrighted work, so long as the amount copied is, quantitatively and qualitatively, an insignificant portion of the copied work.



A copyright plaintiff's burden to establish substantial similarity as an element of infringement effectively permits others any use of the copyrighted work that does not result in a second work that is substantially similar to the copyrighted work. Consequently, it is apparent that the requirement of substantial similarity imparts a hollow sound to petitioner's wail that "the lower courts are granting indirect protection to facts, contrary to §§ 102(b) and 103(b)." Pet. Br. at 17, 19.

Professor Denicola anticipates and peremptorily disposes of that plaint:

Recognizing a property interest in the collection of information contained in a copyrighted compilation need not raise the spectre of a monopolist stifling future intellectual activity. Unfettered access to individual facts would continue to be assured by the traditional requirement of substantial similarity. Since it is the collection as a whole that represents the original work of authorship, only copying sufficient to produce a substantially similar collection would generate potential liability.

Denicola, *supra* p. 16, at 531 (footnote omitted) (emphasis added).

*Worth v. Selchow & Righter Co.*, 827 F.2d 569 (9th Cir. 1987), *cert. denied*, 485 U.S. 977 (1988), is instructive of the manner in which application of the substantial similarity requirement operates to afford a second comer access to and use of a compilation of data. In *Worth*, the Ninth Circuit permitted creators of the game *Trivial Pursuit* to use as a source of factual information two volumes of *Worth's* copyrighted encyclopedia. Even though the accused infringers relied on approximately 4,000 of the 12,000 discrete entries in the encyclopedia, the court found that the accused work was not substantially similar to *Worth's* copyrighted encyclopedia. This outcome was a result of the court's application of

a more stringent similarity requirement to factual works,<sup>14</sup> *id.* at 572, and the fact that the factual data was arranged and presented differently in the game than it was in the encyclopedia.

As Professor Denicola has noted:

It is impossible to dictate in advance the extent of an appropriation of information necessary to justify a finding of infringement. Presumably a less appropriation of data would suffice when additional aspects of the work have also been taken, since the substantial similarity test measures cumulative effect. The question of degree is troublesome, but no more so than in other contexts in which judge or jury confront the issue of substantial similarity.

Denicola, *supra* p. 16, at 532.

<sup>14</sup> The Ninth Circuit relied on *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485 (9th Cir.), *cert. denied*, 469 U.S. 1037 (1984) for the proposition that "[b]ecause authors who wish to express ideas in factual works are usually confined to a 'narrow range of expression . . . , similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed.'" *Worth* at 572 (quoting *Landsberg* at 488).

However, at least one commentator believes that the application of a higher standard of substantial similarity to nonfictional works than to fictional works is erroneous:

There is no reason, factual or legal, justifying the establishment of a different standard of substantial similarity for any class of work. It is noteworthy in this regard that in reversing the Second Circuit's decision in *Harper & Row*, . . . the Supreme Court held: "We agree with the Court of Appeals that copyright is intended to increase and not to impede the harvest of knowledge. But we believe the Second Circuit gave insufficient deference to the scheme established by the Copyright Act for fostering the original works that provide the seed and substance of this harvest." (citations omitted)

W. Patry, *supra* note 8, at 197, n.31.



In any case, mere rearrangement of the data collected in a copyrighted directory should present no impediment to a finding of substantial similarity. Even if rearranged, the accused work may be found to have misappropriated a substantial portion of the protectible expression of the copyrighted work, insofar as that expression flows from the collection of data in the original. In addition, and in all likelihood, the accused work will achieve the status of an infringing derivative work.

Although it is apparent that pronouncements regarding substantial similarity must be made on a case-by-case basis, by any rational measure petitioner's directory is substantially similar to the expression protected by respondent's copyright.

#### IV. PETITIONER'S "INDEPENDENT VERIFICATION" OF LISTINGS TAKEN FROM RESPONDENT'S DIRECTORY DOES NOT MITIGATE INFRINGEMENT.

In the proceedings below, petitioner contended that the effort it expended in independently verifying individual listings taken from respondent's directory before transporting them to its own should operate in mitigation of infringement. See, *Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 663 F. Supp. 214 (D. Kan. 1987), *aff'd mem.*, 916 F.2d 718, *cert. denied*, 59 U.S.L.W. 3209 (U.S. Oct. 2, 1990) (No. 89-1909). For the reasons propounded below, petitioner's efforts in the nature of "independent verification" are unavailing.

It is almost axiomatic in copyright law that a second comer who uses a copyrighted work to produce a work that is substantially similar to the copyrighted work will be guilty of infringement. An exception to the general proposition occurs

when the second comer uses access<sup>15</sup> to the copyrighted work as a guide to appropriate source material. See, e.g., *Moffat & Paige, Ltd. v. George Gill & Sons*, 86 L.T.R. (n.s.) 465 (1902); *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977); *Grove Press, Inc. v. Collectors Publications, Inc.*, 264 F. Supp. 603 (C.D. Cal. 1967).

However, the right to use the copyrighted source, even as a "guide," appears to be circumscribed. In *Rockford Map*, the Fifth Circuit said:

All concede, as Learned Hand said in *Jewelers'* [sic] *Circular*, . . . that "a second compiler may check

<sup>15</sup> Petitioner below had advanced notions separate from copyright in its efforts to gain access to respondent's directory listings. Specifically, Feist argues that RTSC's copyright claim is circumvented by RTSC's legal duty to freely make available an "essential facility" (RTSC's white pages) to its competitors.

To establish liability under the essential facilities doctrine, a plaintiff must show: (1) control of the essential facility by a monopolist; (2) a competitor's inability practically or reasonably to duplicate the facility; (3) denial of the use of the essential facility to a competitor; and (4) the feasibility of providing the facility. *MCI Communications Corp. v. American Tel. and Tel. Co.*, 708 F.2d 1081, 1132-33 (7th Cir.), *cert. denied*, 464 U.S. 891 (1983) (citing *Otter Tail Power Co. v. United States*, 410 U.S. 366 (1973); *United States v. Terminal R.R. Ass'n*, 224 U.S. 383 (1912)).

In the antitrust proceeding below, the lower court was not convinced that RTSC's white pages listings constituted an essential facility. The court reasoned that the information contained in the white pages listings could be independently obtained from other sources. Moreover, the court found that acquiring such information was neither impossible or economically impractical. See *Rural Tel. Serv., Inc. v. Feist Publications, Inc.*, 737 F. Supp. 610 (D. Kan.), *recon. denied*, 1990-2 Trade Cases (CCH) ¶ 69,236 (1990).

Although the antitrust issues are not before the Court, the essential facilities doctrine is relevant in that it represents a potential mechanism for providing relief, in appropriate circumstances, to qualified parties who require access to copyrighted material. The courts below considered these circumstances not to be appropriate, and petitioner not to be so qualified.

back his independent work upon the original compilation." The right to "check back" does not imply a right to start with the copyrighted work. Everyone must do the same basic work, the same "industrious collection." "A subsequent compiler is bound to set about doing for himself what the first compiler has done." *Kelly v. Morris*, [1866] 1 Eq. 697, 701 . . . . The second compiler must assemble the material as if there had never been a first compilation; only then may the second compiler use the first as a check on error. Here, as in *Schroeder*, the second compiler started with the selection, ordering, and arrangement of the first. The district court found that Directory Service "did not make an independent production. To the contrary, it merely took the copyrighted . . . information and edited it." That Directory Service made some changes is irrelevant; the starting point itself offended.

768 F.2d at 149 (citations and footnote omitted).

It is clear that the only activity countenanced by the courts is the independent canvass. For example, the district court, in *Central Tel. Co. of Va. v. Johnson Publishing Co.*, 526 F. Supp. 838 (D. Colo. 1981), conceded that:

Courts recognize that a compiler of a directory may make fair use of an existing compilation if he first makes an independent canvass, then merely compares and checks his own compilation with that of the copyrighted publication and publishes the result after verifying the additional items derived from the copyrighted publication. . . . Since the copyright covers the compilation of the information and not the individual names and addresses, if there is substantial copying from the plaintiff's work without an independent canvass initially, the resulting work will be an infringement even when the defendant

later verifies the material by checking the plaintiff's original sources.

*Id.* at 843 (citations omitted). *Central Telephone* was quoted with approval below. See *Rural Tel. Serv. Co.*, 663 F. Supp. at 221.

And the late Professor Nimmer appears to agree in general that:

Verification of the accuracy of previously collected material by checking it against similar material contained in a copyrighted work does not itself constitute actionable copying, even where minor changes of spelling, etc., are made directly from the protected work as a result of the check.

2 Nimmer, *supra* note 12, § 8.01[D], at 8-20 (footnote omitted).

However, he cautions that there are limits on what the second comer may do in the way of cross-checking. "If, however, there is substantial copying from the plaintiff's work, the resulting work will be an infringement even if the defendant then verifies the material by checking the plaintiff's original sources." *Id.* at 8-20 (citing *W. H. Anderson Co. v. Baldwin Law Publishing Co.*, 27 F.2d 82 (6th Cir. 1928); *Central Tel. Co. of Va. v. Johnson Publishing Co.*, 526 F. Supp. 838 (D. Colo. 1981); *Produce Reporter Co. v. Fruit Produce Rating Agency*, 1 F.2d 58 (E.D. Ill. 1924)).

*United Tel. Co. of Mo. v. Johnson Publishing Co. Inc.*, 855 F.2d 604 (8th Cir. 1988), presents a factual situation that appears to be analogous in all material aspects to the situation here. In *United Telephone*, the Eighth Circuit affirmed a grant of summary judgment of infringement, even though the accused infringer, Johnson, had independently verified all



but 214 of the approximately 5,000 listings it had taken from United's directory.<sup>16</sup> The Eighth Circuit held that:

By comparing its 1985 City Directory white pages with United Telephone's 1985 Phone Book white pages, Johnson discovered and obtained the names, addresses, and telephone numbers of new subscribers for telephone service. Johnson then copied this information into its City Directory computer data base. . . . By copying this information directory into its computer data base, Johnson has "taken" from United Telephone's compilation of its listings, and has copied "material contributed by the author." This copying by Johnson violates United Telephone's exclusive right to reproduce its 1985 Jefferson City Phone Book, and is an infringement of its copyright.

*Id.* at 608.

The Eighth Circuit held also that Johnson's reprinting of information from United's white pages into Johnson's white pages was an infringement. *Id.* at 612-613.<sup>17</sup>

<sup>16</sup> Johnson's City Directories contained additional information not available in United's white pages, including: names of spouses, occupation, names and years of birth of children, and whether or not residents owned their own homes. 855 F.2d at 606.

<sup>17</sup> It seems likely that because of the substantial additional data provided by Johnson in its City Directories, the City Directories would qualify for copyright protection. However, they would also undoubtedly assume the status of derivative works.

Something of a gloss has been imparted to the statutory definition so that, at least in some circuits, a work is considered a derivative work "only if it would be considered an infringing work if the material which it had derived from a prior work had been taken without the consent of the copyright proprietor of the prior work." *Litchfield v. Spielberg*, 736 F.2d 1352, 1354 (9th Cir. 1984) (citing *United States v. Taxe*, 540 F.2d 961 (9th Cir. 1976)).

(footnote continues)

Accordingly, copyright law allows independent creation of works even though the works are substantially similar to a copyrighted work. In addition, a second comer may use a copyrighted work as a "guide" to public domain sources. With respect to telephone directories, courts have indicated that an independent publisher must conduct his own canvass. Independent verification, after access to and borrowing from a copyrighted work, does not mitigate infringement. This result follows directly from well-settled copyright infringement considerations, which establish that infringement is found by proof of: (i) access to the copyrighted work by the accused infringer and (ii) substantial similarity of the accused work to the protected expression of the copyrighted work. See 3 Nimmer, *supra* note 12, at Ch. 13. Even if petitioner's directory were assumed, *arguendo*, to represent an improvement upon respondent's, infringement would still lie. See, e.g., *American Visuals Corp. v. Holland*, 261 F.2d 652 (2d Cir. 1958).

(footnote continued)

In any event, the right to create derivative works based on his copyrighted work is one of the exclusive rights bestowed on a copyright owner under the Copyright Act. See 17 U.S.C.A. § 106(2). Therefore, creation of an unauthorized derivative work is an act of copyright infringement. Because of this, Johnson's ability to enforce purported copyrights in its City Directories, and Feist's right to do so in its AREA-WIDE directories, is problematic. See 1 Nimmer, *supra* note 12, § 3.06, at 3-22.2 to 3-23.



**CONCLUSION**

Respondent possesses a valid copyright in its telephone directory. Petitioner's use of respondent's directory as a source from which to create its own directory is an act of infringement. "Independent verification" does not excuse petitioner's infringement. Therefore, the judgment of the Court of Appeals should be **AFFIRMED**.

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